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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,233	03/11/2004	Carlos A. Khantzis	20850.150	8602
21907 7590 07/03/2007 ROZSA LAW GROUP LC 18757 BURBANK BOULEVARD SUITE 220 TARZANA, CA 91356-3346			EXAMINER KAVANAUGH, JOHN T	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 07/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800.233

Applicant(s)

KHANTZIS, CARLOS A.

Examiner

/Ted Kavanaugh/

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 32-45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 32-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4,6,7,10,11,12,35,37,38,41,42,43 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4557060 (Kawashima).

Kawashima teaches a foot wearing item including an insole (1), a midsole and an outsole (see the figures and col. 2, lines 29-32) comprising a flexible and deformable material (foam insert 4; see col. 1, lines 61-64) fitted within a cavity in the front portion of the sole. The foam insert 4 is placed underneath the areas of the foot that correspond to the toes and metatarso-phalangeal joint (see figure 4) and therefore will permit the toes to curl downward when walking. Moreover, even if the foam padding was substantially hard, it would still allow the toes to curl downward, this would be possible in most types of footwear. Furthermore, most of the independent claims are broader inasmuch as they call for "the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking".

3. Claims 10,12,13,41,43,44 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4211236 (Krinsky).

Krinsky teaches a foot wearing item including an insole (top layer 18 of cushion 10 is inherently an insole inasmuch as it is placed in the shoe and makes contact with

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the foot; see col. 3, lines 25-27) comprising a flexible and deformable material (flowable, highly viscous material 34) aligned with the insole. The cushion is placed underneath all areas of the foot including the toes and metatarso-phalangeal joint (see figure 3) and therefore will permit the toes to curl downward when walking.

Regarding claim 12 and the like, see col. 1, line 13-15 wherein it refers the cushion can be used by athletes and therefore the cushion can inherently be used in athletic shoes.

Regarding claim 13 and the like, the cover 18 or 20 or second envelope 60 can all serve as a cover.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236.

Krinsky teaches a footwear item as claimed (see the rejection above) except for the viscous material being one of those claimed. Krinsky doesn't provide a list of different types of viscous material that can be used. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the viscous flowable material out of gel or the like, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

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its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 14 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236 in view of official notice

Krinsky teaches a footwear item as claimed (see the 102 rejection above for details) the flexible and deformable material treated with a fungicide. The examiner takes official notice that it is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide. Therefore, it would have been obvious to provide the flexible and deformable material of Krinsky with a fungicide, to prevent fungus.

7. Claims 1-6,8-14 and 32-37,39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236 in view of Official Notice.

Krinsky teaches a foot wearing item including a deformable padding (cushion 10 is placed in the shoe and makes contact with the foot; see col. 3, lines 25-27) comprising a flexible and deformable material (flowable, highly viscous material 34). The cushion is placed underneath all areas of the foot including the toes and metatarso-phalangeal joint (see figure 3) and therefore will permit the toes to curl downward when walking. Some of the claims only require the toes to flex or bend; such as claims 1,4,32,35 which is extremely broad with that aspect. Krinsky teaches the deformable padding placed in a shoe but doesn't teach the aspects of the shoe. The examiner takes official notice that it is old and conventional in the art to have a shoe which includes an outsole, a midsole and an insole. Therefore, it would be obvious to place the deformable padding (cushion 10) of Krinsky in a shoe having an insole, a midsole

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and an outsole. The cushion is placed on top of the insole and therefore is aligned with the insole.

With regard to the deformable material be a gel or the like, Krinsky doesn't provide a list of different types of viscous material that can be used. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the viscous flowable material out of gel or the like, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

Regarding claim 5 and the like, the cushion appears to have a thickness as claimed. To the extent that it does not, it would appear to be an obvious design choice to construct it with a thickness as claimed inasmuch as a number of different thicknesses appear to be suitable depending on the size of the wearer and the sport being played.

Regarding claim 6 and the like, an insole is naturally placed over the midsole and therefore is aligned with the midsole.

Regarding claim 12 and the like, see col. 1, line 13-15 of Krinsky wherein it refers the cushion can be used by athletes and therefore the cushion can inherently be used in athletic shoes.

Regarding claims 2 and 13 and the like, the cover 18 is a cover and is capable of being stretched and therefore is a stretched material.

Regarding treating the padding with a fungicide, the examiner takes official notice that it is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide. Therefore, it would have been obvious to provide the deformable padding as taught above with a fungicide, to prevent fungus.

8. Claims 1 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima '060 in view of US 4768295 (Ito).

Kawashima teaches a footwear item as claimed (see the 102 rejection above for details) except for the deformable material being a gel. Ito teaches a cushioning member placed in a cavity of the sole filled with a gel. It would have been obvious to one of ordinary skill in the art to form the cushioning members of Kawashima to be a gel filled cushioning member, as taught by Ito, to facilitate absorbing the shock instantly.

9. Claims 5 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima.

Kawashima teaches a foot wearing item (see the details in the 102 rejection above) except for the thickness of the deformable padding. The padding appears to be of the depth as claimed, however the dimensions are not given. It would appear to be an obvious design choice to construct the padding with a thickness as claimed inasmuch as a number of different thicknesses appear to be suitable depending on the size of the wearer and the sport being played.

10. Claims 2,33 and 8,13,39,44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1,32 and 4,10,35,41, respectively above, and further in view of US 5775005 (McClelland).

McClelland teaches providing a sock lining 28 to cover the insole. It would have been obvious to provide the insole as taught above with a sock liner on top, as taught by McClelland, to provide additional comfort to the wearer. The sock liner is a conventional sock liner, which is inherently capable of being stretched, and therefore are a stretched material.

11. Claims 3,34 and 9,14,40,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1,32 and 4,10,35,41, respectively above, and further in view of Official Notice.

The examiner takes official notice that it is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide. Therefore, it would have been obvious to provide the deformable padding as taught above with a fungicide, to prevent fungus.

Response to Arguments

12. Applicant's arguments filed 6-12-2007 have been fully considered but they are not persuasive.

Throughout the remarks applicant has continually argues how the prior art and applicant's invention are different.

However, these arguments are moot inasmuch as applicant "must present arguments pointing out the specific distinctions believed to render the **claims**...patentable over any applied references", 37 C.F.R. 1.111. Only these types are arguments will be addressed. It is helpful that applicant shows the distinction

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between his invention and the prior art but these distinctions must be in or added to the claims.

Applicant argues that the foam insert 4 of Kawashima "is not located in an area encompassing the tips of the toe to the base of the toes, but is instead from the base of the toes to the balls of the feet".

In response, the claims do not call for the padding to "encompassing the tips of the toe to the base of the toes". The claims only call for "so that all five toes rest on the deformable padding" and therefore as applicant admits it at least does support the base of the toes. Moreover, if applicant were to amend the claims as such the language applicant is relying on is only functional language and the shoe structure of Kawashima is inherently capable of supporting the "tips of the toe to the base of the toes". The foam insert 4 of Kawashima extends well into the forefoot area of the sole and there is usually a open spacing between the end of the shoe and the tip of the toes so as to not cram the toes in the end of the shoe and/or to allow room for one's foot to grow.

Applicant argues while the gel of Krinsky "is flowable, highly viscous material, the gel is under the pressure of the entire body and cannot therefore be grippable, or graspable by the toes along as the pressure will prevent localized movement under the pads of the toes".

To the contrary, if the gel material is highly viscous material, it therefore would be graspable and grippable inasmuch as when the wearer's bends their toes it would extend inward in the deformable padding. Moreover, the claims don't call for it to be grippable but instead call for the padding or the deformable gel "permits the toes to curl,

flex, bend or grasp downward when a wearer of the shoe is walking". Therefore, only one of these functions have to be satisfied. This functional language is extremely broad inasmuch as toes in almost any shoe would be permitted to flex, bend, or grasp downward when a wearer of the shoe is walking. There is usually plenty of room in the toe areas of shoes to permit the wearer to bend or flex their toes when desired.

Regarding claim 12, applicant argues Krinsky and Kawashima do teach being used in an athletic shoe but it would be impractical to be applied to other types of shoe such as dress shoes and sandals.

In response, this argument is not understood inasmuch as only one of the items (i.e. shoes, sandals, flip-flops or athletic shoes) from claim 12 have to be satisfied. The patents of both Kawashima and Krinsky are used in shoes.

Regarding claims 11 and 42, applicant argues that the gel material of Krinsky is highly viscous and therefore would not satisfy the limitations of these claims.

In response, claims 11 and 42 include a grouping of several materials and one of them being polyurethane gel and non-leaking semi-solid gel, and in the rejection above it has been noted that Krinsky doesn't provide a list of different types of viscous material that can be used. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the viscous flowable material out of gel or the like, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The gel of Krinsky is enclosed in a casing and therefore would be non-leaking.

Applicant argues that the present device is for tactile stimulation and "it is not old and conventional to have tactile stimulation treated with a fungicide".

In response, it is not applicant invention that is being provided with fungicide. A device that has tactile stimulation is not even being claimed and therefore these argument are moot.

Regarding claim 5, applicant argues that "the depth of thickness [of Krinsky design] under the toes is significantly less than 6 mm". Bold face added.

In response, the figures of Krinsky are not drawn to scale inasmuch as figure 3 shows a foot less than 4 inches and therefore for an adult size the deformable padding would easily be at least 6 mm in depth and moreover in the arch area it would be substantially larger than 6 mm in depth. Moreover, as stated in the rejection above, to the extent that it does not, it would appear to be an obvious design choice to construct it with a thickness as claimed inasmuch as a number of different thicknesses appear to be suitable depending on the size of the wearer and the sport being played.

Regarding claim 6, Applicant argues that the deformable padding of Kawashima and Krinsky does not lie within the insole like the cushion of the invention inasmuch as the present invention "lies through the insole of the shoe and into the midsole of the shoe".

In response, such limitation is not being claimed and therefore is moot. The claim is broad inasmuch as it only calls for "padding is aligned with a portion of the midsole in addition to being aligned with the insole". The padding can be stacked on

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top of the insole and midsole or be sitting next to these items and still satisfy the broad limitation of this claim.

Applicant argues that "Kawashima patent resides not in the insole of the shoe, but lies above and upon the insole of the shoe", therefore "it is impossible to have a cushion of at least 6 mm, as well as the entire foot or even just the toes inside the interior of a shoe.

In response the patent of Kawashima does not reside on the insole. Kawashima is actually teaching an insole 1 that goes in a shoe and not on top of another insole. The foam insert 4 is substantially recessed in a cavity in the insole 1, as shown in figures 1 and 4. The padding (foam insert 4) appears to be of the depth as claimed, however the dimensions are not given. It would appear to be an obvious design choice to construct the padding with a thickness as claimed inasmuch as a number of different thicknesses appear to be suitable depending on the size of the wearer and the sport being played.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

--“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

--Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300

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(FORMAL FAXES ONLY). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
June 23, 2007